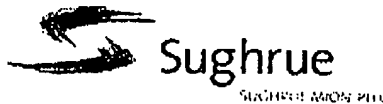


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Date October 5, 2005

To Examiner Peter Vincent Agustin

Of PTO Group Art Unit 2652

Fax 571 273 8300

From Andrew J. Taska

Subject Notice of Appeal and Pre-Appeal Brief Request for Review

Our Ref Q68841 Appln No 10/092,296

Conf No 2668 Inventors Akihiro DENDA, et al.

Pages 11 (including cover sheet)

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Sir:

I hereby certify that the above identified correspondence is being facsimile transmitted to Examiner Peter Vincent Agustin at the Patent and Trademark Office on October 5, 2005 at 571 273 8300.

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<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional) <b>Q68841</b>	
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		First Named Inventor <b>Akihiro DENDA</b>	
		Art Unit <b>2652</b>	Examiner <b>Peter V. Agustin</b>
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.  This request is being filed with a notice of appeal.  The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <b>54,666</b> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34 Registration number if acting under 37 CFR 1.34 _____		Signature <i>Andrew J. Taska</i> <b>Andrew J. Taska</b> Typed or printed name <b>202 293 7060</b> Telephone number <b>October 5, 2005</b> Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.			
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OCT 05 2005

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of

Docket No: Q68841

Akihiro DENDA, et al.

Appln. No.: 10/092,296

Group Art Unit: 2652

Confirmation No.: 2668

Examiner: Peter Vincent Agustin

Filed: March 07, 2002

For: INFORMATION REPRODUCING APPARATUS AND METHOD

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Pursuant to the new Pre-Appeal Brief Conference Pilot Program, and further to the Examiner's Final Office Action dated May 5, 2005, Applicants hereby file this Pre-Appeal Brief Request for Review. This Request is also accompanied by the filing of a Notice of Appeal.

Status of the Application:

Claims 1-13 are all of the claims that have been examined in the present application. Claims 4-13 have been rejected. Claims 1-3 have been allowed.

Claim Rejections which are the Subject of this Appeal:

The Examiner has rejected claims 4, 5, and 7-11 under 35 U.S.C. § 102(c) as being anticipated by U.S. Patent No. 6,292,440 to Lee (hereinafter "Lee").

In view of the following discussions, Applicants respectfully submit that the rejection of these claims is improper.

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**  
**U.S. Application No.: 10/092,296**

**Attorney Docket No. Q68841**

**Summary of Rejection:**

In rejecting the claims, the Examiner relies on Lee, which discloses a Moving Pictures Experts Group audio layer-3 (MP3) car player. The MP3 player disclosed in Lee contains a file type detector 100, which receives audio data and detects whether the audio data are ordinary CD files or MP3 files. As disclosed in Lee, if the input audio data are ordinary CD files, then the data are sent to the digital/analog converter 600. On the other hand, if the input audio data are MP3 files, then the data are provided to the MP3 file input unit 200, after which the data are transmitted to the MP3 decoder 500.

With respect to claim 4, the Examiner alleges that Lee inherently discloses both the feature of a "judgment means for judging if the program information is copied onto the second recording medium when the program information is reproduced," and the feature of a "control means for controlling reproduction of the program information recorded on the first recording medium to be stopped and the program information copied in the second recording medium to be reproduced if it is judged that the program information is copied," as recited in claim 4. In view of the following discussions, Applicants respectfully disagree.

Lee does not inherently disclose the recited "judgment means" and "control means" as alleged.

In rejecting claim 4, the Examiner alleges that Lee inherently discloses the recited "judgment means" because Lee discloses that the file type detector 100 determines whether or not a file is an MP3 file and, if so, provides the data to the MP3 file input unit 200. More particularly, the Examiner alleges that, in Lee, the data are provided to the MP3 file input unit 200 (i.e., when the input audio data are MP3 files), or the data are sent to the digital/analog converter 600 (i.e., when the input audio data are ordinary CD files) and that therefore Lee, although indirectly, nevertheless determines whether information has been copied onto the MP3 file input unit 200. The Examiner's arguments fail for at least two reasons.

First, the Examiner has not identified any aspect of Lee that discloses or suggests judging if program information is copied onto a second recording medium, as recited in claim 4. To the contrary, the Examiner has merely alleged that Lee discloses detecting whether the file of the audio data is an ordinary CD file or an MP3 file. In fact, the determination disclosed in Lee (i.e.,

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**  
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determining the type of information on a disk) does not suggest judging if program information is copied onto a second recording medium, as recited in claim 4.

The Examiner also alleges that Lee discloses providing data to the MP3 file input unit 200 when the input audio data are MP3 files, and sending to the digital/analog converter 600 when the input audio data are ordinary CD files, and that this indirectly corresponds to the recitations of claim 4. That is, the Examiner merely alleges that in Lee, information is either copied or it is not copied depending on a determination of what type of information is on a disk. Even assuming *arguendo* that the Examiner's allegations were accurate, according to the Examiner's rationale, Lee only teaches determining whether to copy, or not to copy, information. In contrast to the recitations of claim 4, however, Lee provides no suggestion whatsoever regarding judging whether information is previously copied onto a second recording medium. Indeed, Lee's determination of the type of data on a disk is completely irrelevant to judging if the program information is copied.

Further, the Examiner has not provided any evidentiary support for his allegation that this claimed feature is inherently disclosed in Lee. To establish inherency, the Examiner must show that a "judgment means for judging if the program information is copied onto the second recording medium when the program information is reproduced," is necessarily present in the MP3 player disclosed in Lee. (MPEP §2112). Indeed, the fact that a "judgment means," as recited in claim 4 may be present in Lee is not sufficient to establish inherency. (MPEP §2112). However, Lee does not disclose reusing the data provided to the MP3 file input unit 200 and, therefore, there is no need for Lee to determine that such information has been copied. As such, this feature is clearly not necessarily present in Lee, as alleged by the Examiner, and, hence, this feature is not inherent to Lee.

In fact, the MP3 player disclosed in Lee judges if the data is to be provided to the MP3 file input unit 200 (which the Examiner alleges to correspond to copying) before the audio data on a CD is reproduced. Consequently, Lee cannot possibly disclose or suggest the feature of judging if the program information is copied onto the second recording medium when the program information is reproduced, as recited in claim 4.

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Second, the Examiner has not pointed to any portion of Lee that discloses or suggests the feature of a "control means for controlling reproduction of the program information recorded on the first recording medium to be stopped... if it is judged that the program information is copied," as recited in claim 4. The Examiner alleges that this feature is also inherent to Lee because Lee stops copying when an ordinary audio CD file is detected.

For *at least* the reasons discussed above, Lee does not disclose or suggest judging that the program information is copied. Further, no portion of Lee suggests stopping the reproduction of information if it is judged that the program information is copied, as recited in claim 4. To the contrary, Lee merely discloses that audio data is not provided to the MP3 file input unit 200 if an ordinary audio CD file is detected. Lee does not disclose that the providing of data from a CD to the MP3 file input unit 200 is ever stopped if it is judged that the audio data is copied, as required by claim 4.

With respect to claim 5, the Examiner alleges that Lee inherently discloses the feature of a "controller... wherein the controller controls the first reproducer not to reproduce the program information on the first recording medium and the second reproducer to reproduce the program information on the second recording medium if the second recording medium contains the program information," as recited in claim 5. In view of the following discussions, Applicants respectfully disagree.

*Lee does not inherently disclose the recited "controller" as alleged.*

In rejecting claim 5, the Examiner alleges that the recited "controller" is inherent to Lee because Lee discloses an MP3 player which determines whether to reproduce audio data from a CD or from a MP3 file input unit 200, based upon whether the file type detector 100 determines that that the CD contains a MP3 file or an ordinary CD file. The Examiner's arguments fail for *at least* the following reasons.

Claim 5 recites that information is not reproduced from the first recording medium, and is reproduced from the second recording medium "if the second recording medium contains the program information" (emphasis added). In contrast to the requirements of claim 4, Lee discloses that information is not produced from a CD, and is produced from a MP3 file input unit 200, if the file type detector 100 determines that that the CD contains a MP3 file rather than an

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**  
**U.S. Application No.: 10/092,296****Attorney Docket No. Q68841**

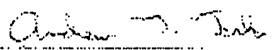
ordinary CD file. That is, Lee determines the information source based upon the data type on the CD, whereas claim 5 requires determining the information source "if the second recording medium contains the program information" (emphasis added). However, Lee fails to disclose or suggest that information is not reproduced from the CD, and is reproduced from the MP3 file input unit 200, if the MP3 file input unit 200 contains the program information, as required by claim 5.

**Conclusion:**

In view of the foregoing, Applicants submit that the Examiner has failed to show that each and every element recited in claims 4 and 5 is either expressly or inherently described in the cited Lee reference, as required by MPEP § 2131. More particularly, The Examiner acknowledges that Lee does not expressly disclose the recited "judgment means," "control means" and "controller," recited in claims 4 and 5, and has failed to provide sufficient evidence to support a finding that these features are necessarily present in Lee (and are thereby inherent in Lee).

Accordingly, Applicants hereby submit that the independent claims 4 and 5 are not anticipated by (i.e. is not readable on) the applied Lee reference for *at least* these independent reasons. Further, Applicants respectfully submit that the dependent claims 7-11 are allowable *at least* by virtue of their dependency on claims 4 and 5. Therefore, Applicants hereby request that the rejections with respect to claims 4-5 and 7-11 be withdrawn.

Respectfully submitted,

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Date: October 5, 2005